UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte CURT J. WITTE, JAMES A. GRUNDNER, and
BASIL EVRENIDIS

_____

Appeal 2008-1038
Application 09/677,993
Technology Center 3600

_____

Decided: [Date of mailing]

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Before WILLIAM F. PATE, III, LINDA E. HORNER, and
JOHN C. KERINS, *Administrative Patent Judges.*

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Curt J. Witte et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3-7, 10-14, 16-23, 25, 26, 28-32, 35-39, 41-48, 50-54, 57-61, and 63-67. Claims 2, 15, 24, 27, 40, 49, and 62 have been canceled. Claims 8, 9, 33, 34, 55, and 56 have been objected to as being dependent on rejected base claims, but the Examiner indicated these claims contain allowable subject matter. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention pertains to selecting a job post site to which a job opening description may be posted. Claim 1, reproduced below, is representative of the subject matter on appeal.

> 1.   A method of selecting a job post site, comprising:
>
> obtaining at least one job post site selection criterion;
>
> automatically ranking a plurality of job post sites based on the at least one job post site selection criterion, comprising:
>
> accessing a fact table that contains data relevant to the at least one job post site selection criterion; and

> using an inference engine to process the at least one job post site selection criterion and the fact table to rank the plurality of job post sites based on the at least one job post site selection criterion; and
>
> selecting the job post site from the plurality of job post sites based on the ranking of the plurality of job post sites.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Callan et al., (Callan), *Searching Distributed Collections With Inference Networks,* Annual ACM Conference on Research and Development in Information Retrieval: Proceedings of the 18th Annual International ACM SIGIR Conference on Research and Development in Information Retrieval, 21-28 (1995).

Qureshi et al., (Qureshi), *Artificial Intelligence in Accounting and Business,* National Public Accountant, vol. 43, no. 7, 13-18 (1998).

Webhire Links Corporate Recruiting Desktops to Over 2,000 Job Posting Sites (Webhire), Business Wire, 1 (2000).

The Appellants seek our review of the Examiner's rejection of claims 1, 3-7, 10-14, 16-23, 25, 26, 28-32, 35-39, 41-48, 50-54, 57-61, and 63-67 under 35 U.S.C. § 103(a) as unpatentable over Webhire, Callan, and Qureshi.

ISSUES

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 3-7, 10-14, 16-23, 25, 26, 28-32, 35-39, 41-48, 50-54, 57-61, and 63-67 under 35 U.S.C. § 103(a) as unpatentable over Webhire, Callan, and Qureshi. This issue turns on whether one having ordinary skill in the art would have had a reason to use the inference engine and fact table of Callan and Qureshi to rank job post sites in the job site search tool of Webhire.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Webhire discloses an on-line job site search tool that helps recruiters target jobs to the most appropriate career sites, professional organizations, and job boards by allowing the recruiters to indicate the type of position they are filling and receive an online listing of the specific job sites that are most likely to attract qualified candidates for those specific openings (Webhire ¶¶ 2, 6). The recruiter can then use the Webhire system to send that job posting to any desirable recruiting destination. (Webhire ¶ 5).

2. Callan teaches using inference networks to rank all types of
    document collections for relevance to a query, select the best set of
    collections from a ranked list, and merge document rankings that
    are returned from a set of collections (Callan ¶¶ 1, 14-21).

3. Qureshi teaches that expert systems having inference engines can
    be used in any type of business domain and at any level in an
    organization (Qureshi ¶ 5, 6, 9, and 13-36).

4. Qureshi further teaches that the benefits of using expert systems
    having inference engines include: consistency and reliability,
    completeness and timeliness in reviewing transactions, and quicker
    decision making than human experts (Qureshi ¶ 38).

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences
between the subject matter sought to be patented and the prior art are such
that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said
subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727,
1734 (2007). The question of obviousness is resolved on the basis of
underlying factual determinations including (1) the scope and content of the
prior art, (2) any differences between the claimed subject matter and the
prior art, (3) the level of skill in the art, and (4) where in evidence, so-called
secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18

(1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR*, 127 S. Ct. at 1739 (citing *Graham*, 383 U.S. at 12), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

The Supreme Court stated that there are "[t]hree cases decided after *Graham* [that] illustrate the application of this doctrine." *Id.* at 1739. "In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *Id.* at 1739-40. "*Sakraida and Anderson's-Black Rock* are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function." *Id.* at 1740.

The Supreme Court stated that "[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." *Id.* The Court explained:

> Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

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Id. at 1740-41. The Court noted that "[t]o facilitate review, this analysis should be made explicit." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

ANALYSIS

The Appellants present the same arguments for all of the rejected claims (Br. 7-10). As such, we select claim 1 as the representative claim, and the remaining claims stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Webhire discloses a method of selecting a job post site, as recited in claim 1, including obtaining at least one job post site selection criterion, automatically ranking a plurality of job post sites based on the at least one job post site selection criterion, and selecting the job post site from the plurality of job post sites based on the ranking of the plurality of job post sites (Ans. 4). The Examiner also found that Webhire does not expressly disclose how the job post sites are ranked; however, it is clear that Webhire must use some established methodology for successfully

performing such a task (Ans. 6). The Examiner further found that there were various approaches to ranking search results by relevance at the time of the invention, Callan discloses the use of inference engines and fact tables to rank document collections based on the relevance of the documents to a given query, and Qureshi explains the benefits of using expert systems, such as those incorporating inference engines (*id.*). The Examiner concluded that it would have been obvious to modify Webhire to access a fact table that contains data relevant to the job post site selection criterion and use an inference engine to process the criterion and the fact table to rank the job post sites based on the criterion in order to reap the benefits of inference engines as taught by Qureshi (Ans. 6-7).

The Appellants do not contest the Examiner's findings of fact as to the scope and content of the prior art or the differences between the prior art and the claimed subject matter. Rather, the Appellants contest the Examiner's legal conclusion of obviousness. We find that the Examiner has set forth a prima facie case of obviousness under the teaching, suggestion, motivation test, because the Examiner has provided a motivation, based on the stated benefits of expert systems having inference engines as taught in Qureshi, as to why one having ordinary skill in the art would have been led to use such an inference engine and fact table to rank the job post sites of Webhire's system. The Examiner has provided an articulated reasoning with a rational underpinning to support this legal conclusion of obviousness. *See In re*

Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in *KSR*, 127 S. Ct. at 1741.

The Appellants contend that the Examiner erred in finding the subject matter of claim 1 obvious because "none of the cited references include any clear and particular evidence of why it would be desirable to use an inference engine for ranking job post sites" (Br. 9). The Appellants further argue that "Applicants can find no disclosure in either Callan or Qureshi that suggest it may be desirable to use an expert system to address the problem of selecting a job post site from among a plurality of job post site candidates" (*id.*).

We are not persuaded by the Appellants' arguments, because the law of obviousness does not require an explicit teaching, suggestion, or motivation in the references themselves that states the references should be combined in the same way as the claimed invention. *See In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006) ("the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references").

> An explicit teaching that identifies and selects
> elements from different sources and states that
> they should be combined in the same way as in the
> invention at issue, is rarely found in the prior art.
> As precedent illustrates, many factors are relevant
> to the motivation-to-combine aspect of the
> obviousness inquiry, such as the field of the
> specific invention, the subject matter of the
> references, the extent to which they are in the same

> or related fields of technology, the nature of the
> advance made by the applicant, and the maturity
> and congestion of the field.
>
> . . .
>
> Precedent has also recognized that "[t]he
> suggestion or motivation to combine references
> does not have to be stated expressly; rather it may
> be shown by reference to the prior art itself, to the
> nature of the problem solved by the claimed
> invention, or to the knowledge of one of ordinary
> skill in the art."

In re Johnston, 435 F.3d 1381, 1385 (Fed. Cir. 2006) (*citing Medical*

Instrumentation and Diagnostics Corp. v. Elekta AB, 344 F.3d 1205, 1221-

22 (Fed. Cir. 2003)).

Further, the Court in *KSR* made clear that while the requirement of

demonstrating a teaching, suggestion, or motivation is a helpful insight, it is

not a rigid and mandatory formula. *See KSR*, 127 S. Ct. at 1741. The Court

in *KSR* found that it was proper to consider common sense in determining

that "familiar items may have obvious uses beyond their primary purposes"

and noted that "[a] person of ordinary skill is also a person of ordinary

creativity, not an automaton." 127 S. Ct. at 1742.

Thus, we agree with the Examiner that it would have been obvious to

use the familiar fact table and inference engine to rank job post sites,

because Webhire discloses a system that ranks job post sites for recruiters

based on site selection criteria (Fact 1), Callan teaches that an inference

engine with a fact table can be used generally in all types of data collections

to rank document collections (Fact 2), and Qureshi teaches that expert systems having inference engines can be used in any type of business domain and at any level in an organization (Fact 3) and that the use of such expert systems achieves consistent, reliable, fast, and efficient output (Fact 4). A person having ordinary skill in the art is not an automaton, *KSR*, 127 S. Ct. at 1742, and common sense would have directed such a person, knowing that such expert systems were commonly used to rank all types of information in data collections in any type of business domain, to apply a fact table and inference engine to the job post site ranking service of Webhire to achieve consistent, reliable, fast, and efficient output.

Further, Qureshi discloses that many expert systems were in use in business at the time of the invention (Fact 3, Qureshi ¶¶ 13-36), and thus after seeing all of the examples of uses of expert systems in Qureshi, it would have been no more than the predictable use of such an expert system to have applied it to the business environment of Webhire's job post site selection tool to rank job post sites. *See KSR*, 127 S. Ct. at 1740 ("if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill").

CONCLUSION

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1, 3-7, 10-14, 16-23, 25, 26, 28-32, 35-39, 41-48, 50-54, 57-61, and 63-67 under 35 U.S.C. § 103(a) as unpatentable over Webhire, Callan, and Qureshi.

DECISION

The decision of the Examiner to reject claims 1, 3-7, 10-14, 16-23, 25, 26, 28-32, 35-39, 41-48, 50-54, 57-61, and 63-67 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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